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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,033	11/07/2001	Takeshi Oohashi	011022	3978

38834 7590 06/01/2005

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EXAMINER	
THORNTON, YVETTE C	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/926,033	OOHASHI ET AL.	
	Examiner	Art Unit	
	Yvette C. Thornton	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-13,15-18 and 20-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-13,15-18 and 20-26* is/are rejected.

7)☒ Claim(s) *27-29* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is written in reference to application number 09/926033 filed on July 7, 2001 which is a 371 of PCT/JP00/01221 filed on March 2, 2000.

Request for Continued Examination

1. The request filed on July 15, 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/926033 is acceptable and a RCE has been established. An action on the RCE follows.

Oath/Declaration

2. The examiner acknowledges the declaration submitted pursuant to 37 CFR 1.132 by inventor Takeshi Oohashi on March 21, 2005.

Response to Amendment

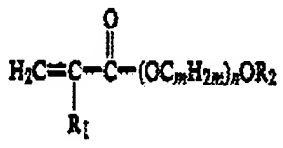
3. Claims 2, 14 and 19 have been cancelled. Claims 1, 3-13, 15-18 and 20-26 are currently pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

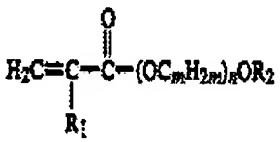
> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-13, 15-18, 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipson et al. (EP 128014 A2) in view of Ishikawa et al. (JP 10-020491 A, machine translation). Lipson teaches a photopolymerization composition comprising (A) from 10-60 parts by weight (pbw) of an addition polymerization material comprised of (i) from 5-50 pbw of an acrylate of the formula:



wherein m is 1-4, n is 1-12, R1 is H, CH3 and mixtures thereof and R2 is

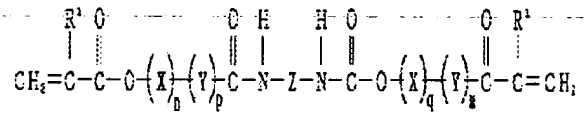
selected from a substituted or unsubstituted phenyl, substituted or unsubstituted naphthenyl, a branched, unbranched, substituted or unsubstituted alkyl having 1-12 carbons, or a substituted or unsubstituted cycloalkyl group having 5-6 carbon atoms in the ring; and (ii) from 5-50 pbw of one or more non-gaseous compounds containing at least two terminal ethylenic groups and having a boiling point of 100°C; (B) from 0.001-20 pbw of a photoinitiated free radical generating addition polymerization initiating system; (C) from 0.001-5 pbw of a thermal addition polymerization inhibitor; and (D) from 40-90 pbw of a preformed macromolecular polymeric binding agent which is a polymer of (i) a first monomer material which contains one or more non-acidic compounds and (ii) a second monomer material which consists essentially of one or more ethylenically unsaturated carboxylic acid or anhydride containing monomers having 3-15 carbon atoms (see claim 1).

Example V exemplifies a composition comprising a copolymer of methyl methacrylate (35%), butyl methacrylate (11%), styrene (23%) and methacrylic acid (30%) in a solvent mixture of methyl ethyl ketone/isopropyl alcohol. It is the examiner's position that the said copolymer meets the limitation of a carboxyl group containing binder, which contains styrene or a styrene derivative. The said copolymer further meets the limitations of the instant claims 4, 16 and 21 wherein the methyl methacrylate (35%) and butyl methacrylate (11%) together meet the requirement of claimed monomer (III) in the amount of 30-75%. The composition of Example V further comprises phenoxydiethoxyethyl acrylate, which has the formula  wherein m=2; n=4; and R2=unsubstituted phenyl group. Although Lipson fails to exemplify a compound wherein n is anything other than 4, one of ordinary skill in the art would have readily envisaged each and every compound within the taught range of n=1-12 (pg. 7, l. 6-pg. 8, l. 10). It is the examiner's position that when n is in the range of 6-12 it anticipates the claimed range of the instant invention. Lipson teaches that the preferred acrylates are substituted and unsubstituted phenoxypolyethoxyethyl acrylates and substituted and unsubstituted phenoxypolypropoxypropyl acrylates

(pg. 9, l. 10-19). The substituents for the phenyl or naphthenyl groups are selected such that they do not substantially adversely affect the characteristics of the photopolymerizable composition and may be halogen (Cl, Br, I) groups, C1-15 alkyl groups and C1-15 alkoxy groups (pg. 8, l. 5-10). Examples of the substituted phenoxypolyethoxyethyl acrylate include chlorophenoxypolyethoxyethyl acrylate and methacrylate (pg. 8, l. 24-25).

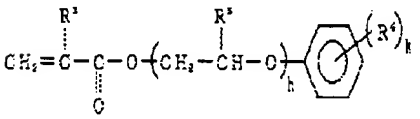
The composition of example V was coated onto a polyester film, dried and covered with a polyethylene film (pg. 35, l. 5-pg. 36, l. 30). The polyethylene cover film is removed and the bared resist coating is laminated to a clean copper-clad epoxy fiberglass board. The resulting film is exposed to light through a high-contrast transparency. The polyester support film is peeled off and the exposed resist layer is developed and etched (pg. 28, l. 17-pg. 29, l. 24).

6. Lipson as discussed above teaches all the limitation of the instant claims except it fails to teach and/or suggest the use of a 2,4,5-triarylimidazole dimer as set forth in the instant claims. Lipson also fails to teach the use of a compound of formula (II) as in instant claims 3, 15 and 20. Ishikawa teaches a photosensitive resin composition comprising (A) a film forming polymer of (meth)acrylic alkyl esters and alkyl methacrylate ester, (B) a photopolymerization initiator, (C) a compound of general formula (I):



(I)

and (D) a compound of general formula (II):

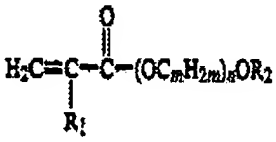


(II)

(see claims; p. 0005-0006). X of formula (I) is -CH2CH2O, Y is selected from a 6 different C3-6 alkoxy groups, Z is a hydrocarbon group having 2-16 carbon atoms and n, m, p and q is an integer from 1-14. (p. 0005). It is the examiner's position that X and Y together meet the limitations of B1 and B2 of claimed formula II. One of ordinary skill in the art would have been motivated by the teachings of Ishikawa to incorporate a compound of general formula (I) into the taught

composition of Lipson in order to increase the sensitivity, intensity and elongation of a the hardened film (see Ishikawa p. 0015).

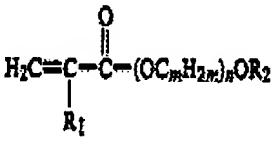
Ishikawa also teaches that suitable examples of the taught photopolymerizable initiator (B) include aromatic ketones, benzoin ethers, 2,4,5-triarylimidazole dimers and acridine derivatives (p. 0011). It would have been obvious to one of ordinary skill in the art to use any photoinitiator, such as 2,4,5-triarylimidazole dimers, which are well known and conventional in the art in the composition of Lipson.

7. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipson et al. (EP 128014 A2) in view of Ishikawa as applied to claims 1, 3-13, 15-18 and 20-23 above, and further in view of Kawashima (US 6048953 A). Lipson as discussed above teaches all the limitation of the instant claims except it fails to teach and/or suggest a composition further comprising 2,2-bis[4-(acryloxypolyethoxy)-phenyl]propane or 2,2-bis[4-(methacryloxypolyethoxy)phenyl]propane as set forth in instant claims 24-26. Lipson does however teach that the taught addition polymerization material comprises (i) from 5-50 pbw of an acrylate of the formula:  and (ii) from 5-50 pbw of one or more non-gaseous compounds containing at least two terminal ethylenic groups an having a boiling point of 100°C. Example of the non-gaseous compounds include ester of the methylene carboxylic acid such as diethylene glycol diacrylate and bis-acrylates and methacrylates of polyethylene and polypropylene glycols such as tripropylene glycol diacrylate (c. 5, l. 60-c. 6, l. 16).

Kawashima (US 6048953 A) teaches the use of a (meth)acrylic monomer (B) having at least one unsaturated double bond in its molecule to adjust the viscosity and the curability of the solvent-less liquid resin composition. Examples include diethylene glycol di(meth)acrylate, tripropylene glycol di(meth)acrylate, 2,2-bis[4-(acryloxypolyethoxy)phenyl]propane and 2,2-bis[4-(methacryloxypolyethoxy)phenyl] propane. It is the examiner's position that Kawashima serves to equate 2,2-bis[4-(acryloxypolyethoxy)phenyl]propane, 2,2-bis[4-(methacryloxypolyethoxy)phenyl]propane,

diethylene glycol di(meth)acrylate and tripropylene glycol di(meth)acrylate in the art. Therefore, one of ordinary skill in the art would have been motivated to substitute 2,2-bis[4-(acryloxypolyethoxy)phenyl]propane or 2,2-bis[4-(methacryloxypolyethoxy)phenyl]propane for the taught diethylene glycol diacrylate and tripropylene glycol diacrylate of Lipson and expect reasonably similar results.

Response to Arguments

8. Applicant's arguments filed March 21, 2005 have been fully considered but they are not persuasive. Applicants argue that the prior art reference of Lipson fails to disclose the specific components (C), (C') or (C") in combination with the clamed dimer. Applicants also argue that Lipson fails to exemplify a compound wherein n is 6-12. The examiner is of the position that Lipson clearly teaches an acrylate of the formula:  wherein m is 1-4, n is 1-12, R1 is H, CH3 and mixtures thereof and R2 is selected from a substituted or unsubstituted phenyl, substituted or unsubstituted naphthenyl, a branched, unbranched, substituted or unsubstituted alkyl having 1-12 carbons, or a substituted or unsubstituted cycloalkyl group having 5-6 carbon atoms in the ring. Example V exemplifies a compound wherein m=2, n=4 and R2 is an unsubstituted phenyl group. The compound of example V is a preferred embodiment. Lipson further teaches that the preferred acrylates are substituted and unsubstituted phenoxypolyethoxyethyl acrylates and substituted and unsubstituted phenoxypolypropoxypropyl acrylates (pg. 9, l. 10-19). In light of the exemplified composition and the disclosure of Lipson, one of ordinary skill in the art would readily envisage a compound similar to that of example V wherein n is in the range of 6-12 and the phenyl is substituted or unsubstituted, which clearly anticipated the claimed invention.

9. In regard to the rejections set forth under 35 USC 103, applicants argue that surprising and unexpected results from compounds within the claimed range. The declaration filed under 37 CFR 1.132

has been fully considered by the examiner. Applicants have also failed to compare the closest prior art of Lipson and Ishikawa. The examiner was unable to make a direct comparison of the claimed invention and the prior art. The declaration uses the composition of example 1 of the present specification with varying acrylate compounds as well as with varying dimmers. The applicants has successfully reproduced example V of Lipson (ex. 7 and 8). However in order to show unexpected results a better comparison would have been to make the composition of example V of Lipson and vary the acrylate component. In other words, the examiner wishes to see an example comprising binder *2, 2,2-dimethoxy-2-phenylacetophenone, trimethylolpropane triacrylate, leuco crystal violet, 2,2'-methylene-bis(4-ethyl-6-tertbutylphenol), benzotriazole, methyl ethyl ketone and an acrylate in the range of m=6-12 (i.e., nonylphenoxyhexaethylenoxyacrylate).

10. Further in regard to the secondary reference of Ishikawa, applicants argue that when properly translation, Ishikawa does not provide proper motivation to one skilled in the art. The examiner respectfully disagrees. Ishikawa serves to establish the affects of the taught dimer in photosensitive compositions. One of ordinary skill in the art would have been motivated by Ishikawa to incorporate a compound of general formula (I) into the taught composition of Lipson in order to increase the sensitivity, intensity and elongation of a the hardened film (see Ishikawa p. 0015). Furthermore one of ordinary skill in the art would have been motivated to vary the amounts of dimer in relation to the taught components of Lipson in order to achieve optimal results.

Allowable Subject Matter

11. Claims 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 571-272-1336. The examiner can normally be reached on Monday-Thursday 8-6:30.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yvette Clarke Thornton
Primary Examiner
Art Unit 1752

yct
May 26, 2005